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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/204,866 12/03/98 JOHNSON

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| EXAMINER |
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QM12/0321

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| WILSON, J | |
| ART UNIT | PAPER NUMBER |

3732

DATE MAILED:

03/21/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/204,866

Applicant(s)

JOHNSON, GARY E.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-29 is/are allowed.
- 6) ☒ Claim(s) 1,4-6,9-11,14 and 15 is/are rejected.
- 7) ☒ Claim(s) 2,3,7,8,12 and 13 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Estrada in view of Hicks. De Estrada shows a tool for the care of a horse's teeth having an electric motor 2, shaft 8', hand piece 1 and guard 11. De Estrada does not show a guard that is a portion of the hand piece. Hicks shows a hand piece 18 for shaft 15 and a guard 25 that is a portion of the hand piece. It would be obvious to one of ordinary skill in the art to modify de Estrada to include a guard that is a portion of the hand piece as shown by Hicks in order to provide more strength. As to claim 5, to provide a tool and guard in different sizes is an obvious matter of choice in the number and size of a known element to the skilled artisan.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Estrada in view of Hicks as applied to claim 1 above, and further in view of Becker (110,103). The above combination does not show a vacuum source and orifice. Becker shows a vacuum source 9 and orifice 10. It would be obvious to one of ordinary skill in the art to modify the above combination to include a vacuum source as shown by Becker in order to remove debris.

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Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Estrada in view of Hicks as applied to claim 4 above, and further in view of Brown. The above combination does not show a clutch. Brown shows a clutch, page 2, lines 90-105. It would be obvious to one of ordinary skill in the art to modify the above combination to include a clutch as shown by Brown in order to allow for control of operation of the tool.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Estrada in view of Hicks as applied to claim 1 above, and further in view of Loddeke et al. The above combination does not show the use of anodized aluminum. Loddeke teaches using anodized aluminum for dental hand pieces. It would be obvious to one of ordinary skill in the art to modify the above combination to include the use of anodized aluminum in order to make use of well known materials for dental tools.

Allowable Subject Matter

Claims 2, 3, 7, 8, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16-29 are allowed.

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Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Conclusion

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.

A handwritten signature in black ink, appearing to read "John J. Wilson", is positioned above the printed name and title.

**John J. Wilson
Primary Examiner
Art Unit 3732**

jjw
March 19, 2001
Fax (703) 308-2708